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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,374	10/30/2001	Gayvin E. Stong	10010660-1	2639

7590 11/17/2005

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
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EXAMINER

KERVEROS, JAMES C

ART UNIT	PAPER NUMBER
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2138

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/021,374

Applicant(s)

STONG ET AL.

Examiner

JAMES C. KERVEROS

Art Unit

2138

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 2-6, 8-12 and 26-32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3. NOTE:

The amendment after final rejection filed on 8/9/2005 has not been entered, because it raises new issues that would require further search and reexamination of the present Application. Independent claim 26 has been amended to remove a built in self-test (BIST). Independent claim 31 additionally recites a built in self-test (BIST) in the preamble.

Claims 2-6, 8-12, 26-29, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lepejian et al. (U.S. Patent No. 5,974,579), and

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lepejian et al. (U.S. Patent No. 5,974,579) in view of Powell et al. (U.S. Patent No. 6,014,336), as set forth in the Final Office Action dated 8/9/2005.

In reference to the rejection of claim 30 under 35 U.S.C. 102(b) as being improper, the Examiner mistakenly included claim 30 under the 35 U.S.C. 102(b) statutory heading, but has not addressed claim 30 as a rejected claim under 102. Claim 30 has been properly rejected under 35 U.S.C. 103(a) as being unpatentable over Lepejian et al. (U.S. Patent No. 5,974,579) as set forth in the Final Office Action. Applicant's request for reconsideration of the finality of the rejection of the last Office action has been considered, however, the finality of that action has not been withdrawn, for the reasons stated above.

Regarding Claim 26, on line 1, the transitional term "comprising" should be added after apparatus.

According to Applicant's definition, "non-deterministic operations" are "contention conditions that would not occur during actual operation of the IC", and therefore Lepejian fails to disclose such a feature, since Lepejian's "transition and capacitively coupled faults" are random unpredictable faults that are not detected that appear only at normal speed operation, and therefore, according to Applicant's assertion, are not detected by the disclosed testing procedure. Applicant further argues, that the purpose of the claimed invention, as recited in the independent claims 26 and 31, is to avoid stimulation of the "non-deterministic operations" during a built in self-test (BIST).

In response to Applicant's argument, the Examiner notes that it is not clear under what mode of operation the "non-deterministic operations" occur, since according to Applicant's arguments, "non-deterministic operations" do not occur either in the normal or test mode. The claimed invention merely recites "a decoder to stimulate only deterministic operations when in a test enable mode". Therefore, Applicant fails to claim the "non-deterministic operations" in relation to a normal or test mode.

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Office Action: Advisory


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